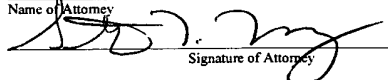




I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patent, Washington, D.C. 20231 on December 3, 2002

Stephen T. Murphy
Name of Attorney


Signature of Attorney

Case 8322R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: :
JUNAN KAO ET AL. : Confirmation No.: 6333
Serial No.: 09/715,354 : Group Art Unit: 1731
Filed: November 17, 2000 : Examiner: Peter Chin
For: TENSION ACTIVATABLE SUBSTRATE

TRANSMITTAL LETTER FOR APPEAL BRIEF

Assistant Commissioner for Patents

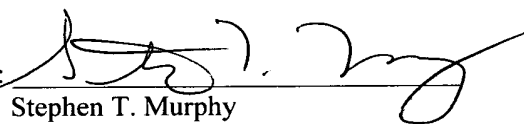
Washington, D.C. 20231

Dear Sir:

Enclosed with this transmittal letter are three copies of Appellants' Brief for the above-identified application pursuant to 37 CFR 1.192. Please charge the fee of \$320.00 pursuant to 37 CFR 1.17(c) to Deposit Account 16-2480. The Commissioner is also authorized to charge any additional fees which may be required to this Account No. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

FOR: JUNAN KAO, ET AL.

By: 

Stephen T. Murphy
Attorney for Applicant(s)
Registration No. 42,917
(513) 634-4268

December 3, 2002

Customer No. 27752

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Stephen J. Murphy

Name of Attorney

Signature of Attorney

#10/BM
12-15-02

Case 8322R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(183)

In the Application of: :
JUNAN KAO ET AL. : Confirmation No.: 6333
Serial No.: 09/715,354 : Group Art Unit: 1731
Filed: November 17, 2000 : Examiner: Peter Chin
For: TENSION ACTIVATABLE SUBSTRATE

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20321

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Sir:

Applicants hereby appeal to the Board of Appeals the decision of the Examiner dated June 6, 2002 finally rejecting Claims 1-20, 24, and 25.

Real Party in Interest:

The real party in interest is the Procter & Gamble Company, assignee of Appellants' entire right, title, and interest in the invention at issue.

Related Appeals and Interferences:

Appellants, Appellants' legal representative, and Appellants' assignee are not aware of any other appeals or interferences which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

Status of Claims:

Claims 1-20, 24 and 25 are the subject of this appeal. No other claims are pending. Claims 21-23 have been canceled. Claims 1-20, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or in the alternative under 35 U.S.C. §103(a) as obvious over Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223].

Status of Amendments:

In response to the June 6, 2002 rejection, Applicants filed a complete set of formal drawings on August 29, 2002 with Figures 1-12 corrected to overcome the Examiner's objections that the drawings were too small. The drawings are attached.

Summary of Invention:

Tissue papers are commonly used as facial tissues, bath tissue, paper towels, napkins and wipes. (Specification Page 1, Lines 22-23) It has long been a goal in the art of making tissue paper to produce a tissue paper having lower density, which also has high bulk. (Specification Page 2, Lines 5-6) However, historically the lower density, high bulk tissue paper referenced in the art have only a single set of intensive properties. (Specification, Page 2, Lines 27-28) Such properties include density, thickness, coefficient of friction, volume (on a unit area basis), surface area (on a unit area basis), and void volume. (Specification Page 2, Lines 27-30) Typically the user cannot significantly affect the density of the tissue paper once the manufacturing process is complete. (Specification Page 2-3, Lines 32-1) The present invention relates to a tissue product that upon activation is transformed from a first state of intensive properties to a second state of intensive properties. (Specification Page 5, Lines 25-28)

The invention comprises a generally planar substrate of tissue paper. This tissue paper is provided with a pattern of lines of weakness. The tissue paper can then be plastically activated in tension. The activation direction may be generally perpendicular to the major axes of the lines of weakness. Once activated, the tissue paper is transformed from the first state of intensive properties to the second state of intensive properties. (Specification Page 5, Lines 17-28)

A substrate according to the present invention may be used as bath tissue, facial tissue, paper towel, napkin, rag, sponge, scrubby, poof, body wash, filter, face mask, pillow material, padding, insulation, packing material, bandage, wound dressing, dyer-added fabric softener, a core for absorbent products such as diapers, sanitary napkins or tampons, a drainage medium for outdoor use, bedding for plants, etc. This substrate, without regard to its end use, is activatable at the point of use or at an intermediate point in the manufacturing process. (Specification Page 5, Lines 8-14)

Issues:

1. Whether Claims 1-20, 24 and 25 are properly rejected under 35 U.S.C. §102(b) as being anticipated by Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No.

2,130,375], Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzing et al [U.S. Patent No. 2,950,223]?

2. Whether Claims 1-20, 24, and 25 are properly rejected under 35 U.S.C. §103(a) as being obvious in view of Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], and Bletzing et al [U.S. Patent No. 2,950,223]?

Grouping of Claims:

The grounds of rejection would be equally applicable to any of appealed Claims 1-20, 24, and 25. The claims stand or fall together.

Argument:

Claims 1-20, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or in the alternative under 35 U.S.C. §103(a) as obvious over Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzing et al [U.S. Patent No. 2,950,223].

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” Verdegal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP §2131 (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP §2131.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Third, there must be a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Examiner. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Appellants respectfully submit that these rejections are improper because none of the references cited by the Examiner anticipate the pending claims since none of the references either expressly or inherently contain each and every element set forth in the claims, nor have the criteria for establishing a *prima facie* case of obviousness been satisfied.

I. Whether Claims 1-20, 24 and 25 are properly rejected under 35 U.S.C. §102(b) as being anticipated by Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223].

Claims 1-20, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223]. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegel Bros., 814 F.2d at 631 (Fed. Cir. 1987), MPEP §2131. “The identical invention must be shown in as complete detail as is contained in the ...claim.” Richardson, 868 F.2d at 1236 (Fed. Cir. 1989), MPEP §2131. Appellants respectfully submit that these rejections are improper because none of the references cited by the Examiner either expressly or inherently contain each and every element set forth in the claims.

The Examiner has concluded that “while the prior references are silent as to the claimed ability to expand upon application of tensile force, it is inherent that the prior art has the claimed property because the same kind of slit or perforations as presently disclosed for the claimed paper is used or present in the prior art paper.” (06/06/02 Final Office Action, Page 2) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ 2d 1955 (Fed. Cir. 1993), In re Oelrich, 666 F.3d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981), MPEP § 2112. “To establish inherency, the **extrinsic evidence** ‘must **make clear** that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added), MPEP §2112. When an Examiner relies on the theory of inherency, the Examiner is required to “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has simply stated that the “cited references show absorbent tissue paper and towel that have slits or perforations going through the thickness of the paper.” (6/06/02 Final Office Action, Page 2) The Examiner further states that “the present

invention achieves the claimed increase in the z-direction or thickness upon application of tensile force in the x/y direction through the use or presence of slits and perforations in the absorbent paper..." (6/06/02 Final Office Action, Page 2) The Examiner has failed to provide a basis in fact or technical reasoning to support that the "slits or perforations going through the thickness of the paper" disclosed in the cited art would **necessarily** result in the claimed expansion in the z-direction. Additionally, Examiner has failed to show that the z-direction expansion would necessarily flow from the teachings of the cited art.

The Examiner has admitted that the "prior references are silent to the claimed ability to expand upon application of tensile force..." (06/06/02 Final Office Action, Page 2) The tissue paper of the present invention comprises a substrate that can be activated by a consumer. (Specification, Page 4, Lines 8-10) Once activated, the tissue paper can increase in thickness in a greater proportion than it increases in elongation. (Specification, Page 5, Lines 6-13 and Claim 1) In one embodiment, after activation, the tissue product increases at least four times in thickness. (Claim 8)

Applicant respectfully submits that the anticipation rejection under 35 U.S.C. §102(b) is improper because each and every element of the claimed invention is not disclosed in the art cited by the Examiner, as no cited art teaches z-direction expansion.

II. Whether Claims 1-20, 24, and 25 are properly rejected under 35 U.S.C. §103(a) as being obvious in view of Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375], Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223].

Claims 1-20, 24 and 25 are rejected under 35 U.S.C. §103(a) as obvious over Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223]. The Examiner concludes that "while the prior references are silent as to the claimed ability to expand upon application of tensile force, it is inherent that the prior art has the claimed property because the same kind of slit or perforations as presently disclosed for the claimed paper is used or present in the prior art paper."

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Third, there must be a reasonable expectation of success of obtaining the claimed invention based

upon the references relied upon by the Examiner. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness, as the Examiner has failed to indicate where a teaching of expansion, either explicit or implicit, appears in the cited references, and thus the cited references fail to teach or suggest all the claimed limitations. See In re Rijckaert, 9 F.3d at 1534. Additionally, the Examiner has failed to point to a suggestion or motivation to modify the references or combine reference teachings to include tissue paper expansion in the z-direction. Finally, the examiner has failed to point to a reference which teaches a reasonable expectation of success. Therefore, the obviousness rejection is improper.

A. The references do not teach or suggest all the claim limitations:

The Examiner states that “the prior references are silent as to the claimed ability to expand upon application of tensile force...” (06/06/02 Final Office Action, Page 2) To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case the cited references do not teach or suggest all the elements of the claimed invention, as none of the cited references teach or suggest the expansion in the z-direction. “The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient [to establish inherency].” In re Oelrich, 666 F.2d at 581-82 (emphasis added). Even if inherency were to be established, “that which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” In re Spormann, 363 F.2d 444, 448 (CCPA 1966). Accordingly, because all the claim limitations are not taught or suggested by the references cited by the Examiner, the Appellants assert the conclusion of obviousness is improper.

B. There is no motivation to modify or combine the references:

Obviousness can only be established by combining or modifying reference teachings to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1491 (Fed. Cir. 1992). In the present case, the Examiner has failed to reference any teachings which would suggest the modification of art to produce the claimed invention. For the references to include an implicit motivation to modify the references to arrive at the claimed invention, the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole must have been suggested to one of ordinary skill in the art. In re Kotzab, 217 F.3d 1365,

1370 (Fed. Cir. 2000), MPEP §2143.01. The Examiner has failed to establish where the teaching in art, knowledge of one of ordinary skill, or the nature of the problem to be solved existed such that it could be suggested to one of ordinary skill in the art. Additionally, the mere fact that references can be modified is not sufficient to establish obviousness. The prior art must also suggest the desirability of doing so. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). The Examiner has failed to point out where the referenced art teaches the desirability of creating a tissue paper product which once activated, is transformed from the first state of intensive properties to the second state of intensive properties. Thus, the modification of the references, and the conclusion that the present invention is obvious is improper.

C. There is not a reasonable expectation of success of obtaining the claimed invention based upon the references:

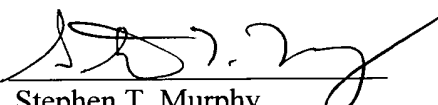
References may be modified or combined to reject claims as *prima facie* obvious only if there is a reasonable expectation of success that the claimed invention will result. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants assert that no art has been provided by the Examiner which points to a reference teaching a reasonable expectation of success of z-direction expansion, as no art cited by the Examiner teaches explicitly or implicitly the claimed z-direction expansion.

Therefore, based upon the references cited, the Examiner has failed to establish that a person of ordinary skill would have a reasonable expectation of success of obtaining the claimed invention, and thus Appellants assert the obviousness rejection is improper.

Conclusion

For the reasons set forth above, Appellants submit that the present invention is novel and unobvious over the cited references. Thus, reversal of the finding of anticipation or in the alternative, obviousness is respectfully requested.

Respectfully submitted,
FOR: JUNAN KAO, ET AL.

By: 
Stephen T. Murphy
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(513) 634-4268

December 3, 2002
Customer # 27752